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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/775,864	01/02/97	NEMES R	

LM41/0420

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EXAMINER	
ALAM,H	
ART UNIT	**PAPER NUMBER**
2771	3

DATE MAILED: 04/20/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Please see attachment

Office Action Summary

Application No.	Applicant(s)
08/775,864	Nemes
Examiner	**Group Art Unit**
Hosain T. Alam	2771

☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-8 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-8 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Part III DETAILED ACTION

1. Claims 1-8 are pending in this application.

Drawings

2. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-4 are rejected under the judicially created doctrine of double patenting over claim 1 of U. S. Patent No. 5,121,495 issued to Nemes, hereinafter ('495) since

the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

5. The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

The retrieval system as claimed in Claim 1 of the '495 patent is directed to an apparatus and method for information storage and retrieval wherein the memory addresses are hashed by using a chain of records having same hash address (see claim 1, col. 12, line 7-8) and wherein the step of removing the expired records is also included.

The "chain of records" is equivalent to a linked list of pointers/addresses of records as claimed and the "chaining" is equivalent to being linked.

As to claims 1 and 3: The '495 patent does not recite the term, "linked list" and instead recites "chain of records".

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use a linked list of records because a chain of records generates a linked list.

As to claims 2 and 4: The '495 patent does not recite the removal based on the determination of a maximum number of expired records.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to group a number of records and thus to predetermine the maximum number in the group to facilitate an efficient processing of records and to reduce the system overhead by avoiding expensive I/O operations based on the number of records in the grouping. The number of records in a group determines the bytes of memory required in the group.

6. Claims 5-8 are rejected under the judicially created doctrine of double patenting over claims 1 and 2 of U. S. Patent No. 5,287,499 issued to Nemes, hereinafter ('499) since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

The retrieval system as claimed in Claims 1 and 2 of the '499 patent is directed to an apparatus and method for information storage and retrieval wherein the memory addresses are hashed by using a chain of records having same hash address, the chaining of records is external (see claim 1, col. 17, line 1).

The "external chaining of records" is equivalent to a linked list of pointers/addresses of records as claimed and the "chaining" is equivalent to being linked.

As to claims 5 and 7: The '499 patent does not recite the term, "linked list" and instead recites "external chaining" and further does not recite the terms, "insert, retrieve or delete" instead recites "storing" (see claim 2, col. 18).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use a linked list of records because a chain of records chained by an external chaining generates a linked list.

As to claims 7 and 8: The '499 patent does not recite a "maximum number of records" instead recite a "threshold".

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to group a number of records for determining the threshold and thus to predetermine the maximum number for the threshold to facilitate an efficient processing of records and to reduce the system overhead by avoiding expensive I/O operations based on the number of records associated with the threshold. The number of records associated with the threshold determines the bytes of memory required for the threshold.

7. Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 1-8 are rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 5,287,499 issued to Nemes ('499) in view of U.S. Patent No. 5,202,981 issued to Shackelford ("Schackelford").

10. With respect to claims 1-8, Nemes teaches everything that is claimed (col. 2, line 60-64, col. 6, line 49-51; '499 reference) except that it does not explicitly indicate the determination of threshold as being the maximum number of records.

Schackelford teaches the maximum number of pointers to records wherein the records are linked in a bidirectional linked list (col. 3, line 61 through col. 4, line 2).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to determine the maximum number of records to make the best use of the memory space available to a user and thus to reduce the system overhead (col. 4, lines 1-2, Schackelford).

11. The above reasoning does not discuss the linked list and the step of removing the records, it rather addresses the issue of determining the maximum number of

records. For the limitations directed to the linked lists and the step of removing, the Applicant is requested to refer to the Obvious Double Patenting rejection set forth hereinabove where they have been discussed in details.

Contact Information

12. Direct inquiries concerning this communication should be directed to Hosain Alam whose telephone number is (703) 308-6662. The examiner can normally be reached on Monday - Thursday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Black, can be reached on (703)305-9707.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

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or faxed to:

(703) 308-9051, (for formal communications intended for entry)

Or:

(703) 305-9724 or (703) 308-6606 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

Inquiries of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-9600.

H.A.

April 14, 1998

THOMAS G. BLACK
SUPERVISORY PATENT EXAMINER
GROUP 2700